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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,923	08/14/2000	Robert Bruce Spertell		8539

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EXAMINER

DAHBOUR, FADI H

ART UNIT	PAPER NUMBER
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3742

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/637,923

Applicant(s)

SPERTELL, ROBERT BRUCE

Examiner

Fadi H. Dahbour

Art Unit

3742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 42-48 and 52-62 is/are allowed.
- 6) ☒ Claim(s) 1-41 and 49-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Double Patenting*

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 8-19 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-12 of prior U.S. Patent No. 6,104,959. This is a double patenting rejection.

### *Claim Objections*

3. Claims 1-41 are objected to because of the following informalities:

In line 1 of each of claims 1, 8, 13, 20, 28, 38 and 39, the first word "The" should be changed to --A--.

Appropriate corrections are required.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7, 20-41, 49-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 49 recites the limitation "switch" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "tissue" in line 8.. There is insufficient antecedent basis for this limitation in the claim.

In claim 28, at the last line, the phrase "target skin surface area" should be changed to --delivery interval period--.

In claim 20, at line 4, the term "preferentially" should be deleted.

In claim 38, at line 6, the term "preferentially" should be deleted.

In claim 39, at line 4, the term "preferentially" should be deleted.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 20-27, are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al (US5595568).

Anderson discloses a method of painless and permanent depilation of parts of the surface of a human body (Figs.9), comprising irradiating the surface with electromagnetic wave energy (see "radiation" in line 4 of abstract) at a frequency that interacts with hair structure preferentially relative to skin tissue (see "hair follicles to be heated...while the surrounding skin region is left relatively free of injury" in lines 6-8 of abstract), locally heating a number of hair follicles (see "hair follicles to be heated" in line 6 of abstract) in a defined surface area with the wave energy (see "area" in line 4 of abstract) while concurrently cooling the skin surface during at least a part of the heating (see "cooling", "cool", "cooled" and "cooler" in lines 50-65 of col.4), and maintaining the heating for less than one second at a sufficient power level to irreversibly damage the hair follicles in the defined surface area (see "between about 50  $\mu$ s and 200 ms" in line 64 of col.7), repeating the sequence at different surface areas until an entire chosen area is depilated (Fig.1, also see "unit is translated and used to treat a separate region" in lines 63-64 of col.8), wherein the defined surface area is greater than 20 mm<sup>2</sup> (see lines 8-10 of col.9) and the levels of the irradiating wave energy are spread throughout the chosen area so that depilation of a number of hair follicles occurs simultaneously (Fig.5B, also see "roughly constant in order to provide a substantially uniform irradiating field" in lines 14-15 of col.9), wherein the energy delivered by virtue of the wattage and duration of the irradiation, is in the range of 10-20 Joules (see "between about 10 and 200" in line 63 of col.9), wherein the irradiation is maintained for in the range of 10 to 1000 ms (see "50  $\mu$ s - 200 ms" in line 26 of col.10), further including the step of cooling the skin surface during at least a part of the irradiation interval (see "cooling", "cool",

"cooled" and "cooler" in lines 50-65 of col.4), wherein the skin is irradiated across a spacing and the cooling is effected by injecting an expanding cooling gas into the spacing (see "gas" in line 52 of col.4) and against the skin surface (see "allows the skin surface to be cooled" in lines 54-55 of col.4), further including irradiating the skin surface through a member defining a target area adhered to the skin and removing the member with destroyed follicles adhering to it after irradiation (46 of Fig.3).

### ***Allowable Subject Matter***

8. Claims 1-7, 28-41, 49-51 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
9. Claims 42-48, 52-62 are allowed.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stauffer, Richards et al ('903), Richards et al ('879), Ren, Evans and Matvias are cited to show methods and devices for delivering microwave energy.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadi H. Dahbour whose telephone number is 703-306-5479.

  
Teresa Walberg  
Supervisory Patent Examiner  
Group 3700

May 30, 2002